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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/807,049	03/23/2004	William Joseph Mahon	031456/272685	4064

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EXAMINER

FOSTER, JIMMY G

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 01/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/807,049

Applicant(s)

MAHON ET AL.

Examiner

Jimmy G Foster

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-62 is/are pending in the application.
- 4a) Of the above claim(s) 1-11 and 42-62 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 34-41 is/are allowed.
- 6) ☒ Claim(s) 12-15 and 19-33 is/are rejected.
- 7) ☒ Claim(s) 16-18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/23/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1) Applicant's election of the claims 12-41 of Group II in the reply filed on 30 November 2004 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement (a requirement of traverse), the election has been treated as an election **without** traverse (MPEP § 818.03(a)).

Claims 1-11 and 42-62 are withdrawn from further consideration.

2) Claims 34-41 are allowable.

3) Claims 25-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 25 indefinitely depends from itself.

4) The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5) Claims 12, 15, 19-24, 29, 30, 32 and 33 rejected under 35 U.S.C. 102(b) as being anticipated by Sperry et al (5,669,902). Sperry et al discloses a bag including an ionomer inner film (melt temp. 180-210° F) and a high density polyethylene (melt temp. 275° F) as the exterior layer of the bag. The bag holds precursor components of polyurethane foam. The polyethylene

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will have self-adhesion at not only 275° F, but also at higher temperatures, including those claimed by applicant.

The term "Coating" typically refers to a process step of laying something down as a liquid on a solid surface. Although the reference of Sperry et al does not disclose laminating the polyethylene on the solid exterior of the bag as a liquid, it appears to the examiner that the structural effect with respect to the product is the same as that of applying the polyethylene on the bag exterior as a solid. With respect to product claims it is well settled that the patentability of a product ordinarily can not depend on its method of being made. See In re Thorpe, 777 F.2d 695, 227 USPQ 964 (1985). Also note MPEP 706.03(e), In re Brown, 59 CCPA 1063, 173 USPQ 685 (CCPA 1972); In re Fessmann, 180 USPQ 324 (CCPA 1974) regarding the Office's lesser burden of proof in product-by-process claims. Therefore, the product claimed is anticipated by the subject matter of Sperry et al.

6) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7) Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over official notice that it is known to provide packaging bags serially/continuously attached on a roll and separated by perforations for separating the bags into units. This makes such bags easily stored together and easily dispensed, and it foregoes the need to separate the bags in the

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manufacturing environment. Accordingly for these reasons, it would have been obvious to have providing the bag disposed on a continuous roll of successive bags, wherein successive bags are detachable from each other by perforation.

8) Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sperry et al. Although the reference of Sperry et al does not disclose a particular density, the foam disclosed will inherently have some density. It has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233. Discovering a workable range, including the range claimed by Applicant, for the foam of Sperry et al would therefore have been obvious to one of ordinary skill in the art.

9) The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Especially, regarding claim 12 and dependent claims, although the reference of Iida et al (5,102,722) discloses a film with an outer heat-resistant coating, which may or may not be self-adhesive at temperatures of 250-450° F, and although the reference discloses the film could be used in food wrappers, there is no suggestion to use the film in a bag having three closed edges and an open edge. Although it may be further known to make food bags with three closed edges and an open edge, there is no suggestion to make the combination with the film of Iida et al, particularly where an exterior coating has a self-adhesion temperature of 250-450° F, and such a coating reduces the self-adhesion of the film at the temperatures below the coating self-adhesive temperature. Although Tankersley (2003/0179957) discloses a bag made of a laminated material which includes an exterior heat resistant coating, the bag does not have an open

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edge, and there is no disclosure that the coating includes the self-adhesion values claimed, with which the self-adhesion of the film would be reduced at the temperatures below the coating self-adhesive temperature.

10) Claims 16-18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11) Claims 25-28 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

12) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jimmy G Foster whose telephone number is (571) 272-4554. The examiner can normally be reached on Mon-Fri, 8:45 am - 5:15 pm.

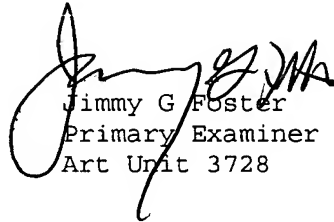
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.



Jimmy G Foster
Primary Examiner
Art Unit 3728

JGF
18 January 2005